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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91184319
Party	Plaintiff Fox News Network, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of

Mark: REDEYE I (& Design)
Application No.: 77,101,706
Published: January 29, 2008

FOX NEWS NETWORK, LLC,

Opposer,

v.

CHICAGO TRIBUNE COMPANY,

Applicant.

Opposition No. 91184319

AMENDED NOTICE OF OPPOSITION

Opposer, Fox News Network, LLC, a Delaware limited liability company located and doing business at 1211 Avenue of the Americas, New York, NY 10036 (“FNC” or “Opposer”), hereby files this Amended Notice of Opposition to registration of the mark “REDEYE I (& Design)” (“REDEYE” or the “Subject Mark”) (U.S. Trademark Application No. 77,101,706) (the “Application”), filed by the Chicago Tribune Company, a Delaware corporation located and doing business at 435 N. Michigan Avenue, Floor 6, Chicago, IL 60611 (“Tribune” or “Applicant”), and published in the Official Gazette of the United States Patent and Trademark Office (“PTO”) on January 29, 2008.

INTRODUCTION

1. In the sworn Application, Tribune represented to the PTO that it had used the Subject Mark in commerce on the Internet and on cable television beginning in 2002 and 2006, respectively. But those statements were knowingly false. First, the Subject Mark has *never* been

used in commerce on cable television within the meaning of the Trademark Act, 15 U.S.C. §§ 1051 and 1127. Indeed, the sworn testimony of several Tribune employees makes it abundantly clear that REDEYE has been used by Tribune on cable television *only* to promote the REDEYE newspaper.

2. Tribune also knowingly misrepresented its use of REDEYE on the Internet. Despite its sworn statement on the Application that it began using REDEYE in commerce on the Internet in October 2002, Tribune did not do so. Instead, until July 2006, Tribune operated the Internet website www.redeyechicago.com solely to promote the REDEYE newspaper. As such, even if Tribune can be said to have used the Subject Mark in commerce as of July 2006 within the meaning of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, Tribune knowingly misrepresented the date of first use in the Application.

3. Further, Tribune knew the true manner in which REDEYE was used on both the Internet and cable television at the time it filed the Application. Indeed, Tribune employees testified under oath about the promotional and/or ancillary use of REDEYE on cable television and the Internet just one month after the Application was filed and before filing the Response to the PTO's Office Action. It is clear that the real reason Tribune filed and continues to pursue the Application is not that it uses REDEYE in commerce in the manner set forth in the Application, but rather that it seeks to harm FNC by seeking – and, indeed, obtaining – priority in registering the Subject Mark.

4. FNC has been damaged by Tribune because the PTO has indicated that it will refuse FNC's application to register its own trademark on the basis of Tribune's fraudulent Application.

5. It is, therefore, clear that Tribune has committed a fraud on the PTO and the

Application should be denied.

FACTUAL BACKGROUND

A. The REDEYE Dispute Between Tribune and FNC

6. FNC is the owner and operator of the Fox News Channel, the number-one rated 24/7 national cable and satellite television news network in the United States. FNC's headquarters are in New York, New York.

7. Tribune owns and operates a free, regional, tabloid-style newspaper called REDEYE that is distributed in the Chicagoland area. Tribune owns federal trademark registrations for REDEYE and REDEYE I (& Design) for "newspapers for general circulation" (Reg. Nos. 2,921,483 and 2,918,012, respectively), which were issued by the PTO on January 25, 2005 and January 11, 2005, respectively (the "Tribune's Registrations"). The REDEYE newspaper was launched on October 30, 2002.

8. Notably, despite the fact that Tribune claims in the Application that it used REDEYE on both the Internet and on cable television beginning on October 30, 2002, Tribune did not file use-based applications, or indeed, any applications for the use of REDEYE on those platforms when it sought the initial registrations for the REDEYE newspaper.

9. At 2 a.m. E.S.T. on February 6, 2007, FNC launched a late-night television program, "Red Eye w/ Greg Gutfeld" ("FNC's Red Eye" or "Red Eye"). FNC's Red Eye, which is filmed in FNC's studios in New York, presents an irreverent, offbeat, humorous spin on the news. It is intended to be the television equivalent of an online weblog (a "blog"), and is hosted by Greg Gutfeld, a former editor of *Maxim UK* who had achieved renown in the blogosphere as the author of the blog "The Daily Gut" (<http://www.dailygut.com>) and as a conservative contributor to "The Huffington Post" (<http://www.huffingtonpost.com>).

10. On February 5, 2007, hours before Red Eye was scheduled to air, counsel for Tribune spoke to counsel for FNC and demanded that FNC not air Red Eye, insisting that Tribune owned a trademark for REDEYE and used the trademark on a cable television news program. Tribune informed FNC that it believed that FNC's use of the title "Red Eye" infringed Tribune's trademark. After some investigation, FNC concluded that FNC's Red Eye did not infringe Tribune's Registrations and the program aired, as planned, on February 6.

11. Two days after the call from Tribune and one day after the first Red Eye aired, on February 7, 2007, Tribune filed the use-based Application for the Subject Mark with the PTO. In its initial Application, which appears to have been filed primarily to gain a litigation advantage in its dispute against FNC, Tribune alleged that it used the Subject Mark:

- in connection with "[p]roviding news, leisure, arts and entertainment information, by means of a global computer network" since October 30, 2002; and
- in connection with "[p]roviding news, leisure, arts and entertainment information, by means of cable television" since January 13, 2006.

12. The Application was signed by Mark W. Hianik, the Assistant Secretary of Tribune, and contains the following language:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are

true; and that all statements made on information and belief are believed true.

13. On February 14, 2007 – just seven days after filing its application for the Subject Mark – Tribune filed a complaint and motion for a preliminary injunction against FNC in the United States District Court for the Northern District of Illinois, alleging trademark infringement and unfair competition under federal law, and state law dilution based on FNC’s Red Eye (the “District Court Action”). Although the complaint in the District Court Action alleges that FNC’s Red Eye infringed Tribune’s Registrations, it emphasized both that the Subject Mark was used on the Internet and on cable television and that the Application had been filed.

14. On April 4, 2007, after a three-day evidentiary hearing, Tribune’s motion for a preliminary injunction was denied. Judge Elaine E. Bucklo of the United States District Court for the Northern District of Illinois held that Tribune had not shown a likelihood of confusion between FNC’s use of RED EYE W/ GREG GUTFELD in connection with its television (and related) services, and Tribune’s use of REDEYE.

15. On June 15, 2007, FNC and Tribune entered into a stipulation of dismissal of the District Court Action pursuant to a confidential settlement agreement, and the District Court dismissed the action with prejudice on June 18, 2007.

16. On May 8, 2007, the PTO issued an Office Action regarding Tribune’s Application, which stated, “The identification of services is unacceptable because the wording ‘news, leisure, arts, and entertainment information’ and ‘by means of cable television’ is indefinite. The applicant must indicate the specific types of news, leisure, art, and entertainment. The applicant must also indicate the nature of the cable services, e.g., production of cable television programs.” The PTO proposed possible language that it said the applicant could adopt, if accurate.

17. On November 8, 2007, Tribune filed its Response to the Office Action (the “Response”), in which it proposed to amend its description of its services to “[p]roviding information on news in the nature of current events reporting, on leisure in the anture [*sic*] of cultural events, music, theater, sports and restaurants; on fine and performing arts; and on entertainment concerning the motion picture industry, the television industry and sports, by means of a global computer network; production of cable television segments featuring news, leisure, arts and entertainment”. This amendment adopted the PTO’s proposed language almost verbatim, but apparently without regard to whether the language was accurate for the Subject Mark. On November 13, 2007, an Examiner’s Amendment changed the word “anture” to “nature” to correct the misspelling.

18. In the Response, Tribune lists the first date of use of the Subject Mark on both the Internet *and* cable television as October 30, 2002. This marked a significant shift from the Application, in which Tribune listed the first use of the Subject Mark on cable television as January 13, 2006.

B. Tribune Made Knowing False Statements In the Application and Response About Its Use Of The Subject Mark On Cable Television

19. The description of the services and the dates of first use in both the Application and the Response were knowingly false at the time they were made.

20. As Tribune knows or should have known at the time it filed its Application, it has never used the Subject Mark in commerce on cable television within the meaning of “use in commerce” as defined by the Trademark Act. Instead, Tribune’s minimal use of REDEYE on cable television is designed solely to promote the newspaper, and/or is normal and ancillary to the sale of its newspaper.

21. As a preliminary matter, there is no Tribune sponsored “Red Eye” television

program on cable television. And there is no television “segment” called the “RedEye segment” that airs on cable television. No such program or segment is listed in any television guide.

22. Indeed, contrary to the false allegations in the Application and the Response, Tribune does not and did not “produce” any cable television segments “featuring news, leisure, arts and entertainment” using REDEYE.

23. Instead, Tribune used REDEYE on cable television to identify one or more reporters from the REDEYE newspaper when they appeared on the CLTV Evening Edition news program.

24. CLTV is, on information and belief, a local cable news network in the Chicagoland area that is owned and operated by Tribune Company (which is also the parent corporation of the Chicago Tribune Company). As part of its daily programming, CLTV airs the Evening Edition news at 7:30 p.m. C.S.T., 8:30 p.m. C.S.T., and 9:30 p.m. C.S.T. The program is thirty minutes long.

25. Reporters from the REDEYE newspaper occasionally appeared on the CLTV Evening Edition between October 2002 and January 2006 and the REDEYE logo was used to signify their affiliation with the newspaper.

26. Beginning in January 2006, a general assignment reporter for the REDEYE newspaper named Kara Kyles (“Kyles”) sometimes appeared on the CLTV Evening Edition for a segment designed to promote the next day’s issue of REDEYE.

27. At the end of each segment, either Kyles or the CLTV anchor said words to the effect of, “You can read more about this story in tomorrow’s REDEYE” or “You can read more about this story in today’s edition of REDEYE”.

28. Upon information and belief, a screen grab of Kyles’ appearance on the CLTV

Evening Edition was submitted along with the Application as a “specimen” of Tribune’s use of REDEYE on cable television.

29. Upon information and belief, neither Kyles nor any other REDEYE reporter currently appears on CLTV Evening Edition and Tribune does not currently use REDEYE on cable television in any manner whatsoever.

30. The purpose of the use of REDEYE on cable television was to promote the newspaper. In fact, Jane Hirt, the editor of the REDEYE newspaper, testified under oath that the use of REDEYE on CLTV “just extends our brand to more viewers, which would presumably hopefully get them to pick up the paper and sign in to our website.” Hirt gave this testimony in the District Court Action shortly after the Application was submitted and before the Response.

31. Accordingly, despite the sworn statements in the Application, Tribune did not and does not use the Subject Mark in commerce within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. §§ 1051 and 1127.

32. Instead, Tribune swore to the following material misrepresentations in the Application regarding the purported use of REDEYE on cable television:

- a) Tribune claims that it uses REDEYE in commerce within the meaning of 15 U.S.C. Section 1051(a), as amended, on cable television. In fact, Tribune did not use REDEYE in commerce within the meaning of 15 U.S.C. Section 1051(a), on cable television at the time the Application was filed or at any other time .
- b) Tribune claims in the Application that it “provid[es] news, leisure, arts and entertainment information, by means of cable television.” In fact, Tribune does not separately use REDEYE in commerce on cable television. Tribune’s use of REDEYE on cable television is a promotional use incidental and ancillary to the distribution of the newspaper, and not a separate use.
- c) Tribune claims in its Response that it has been using the REDEYE mark in commerce on cable television “as least as early as October 30, 2002”. In fact, Tribune has never used REDEYE on television as anything other than a promotional use incidental and ancillary to the distribution of the newspaper, and,

upon information and belief, it did not use the mark on television at all on October 30, 2002.

- d) Tribune states in its Response that it uses REDEYE for the “production of cable television segments featuring news, leisure, arts and entertainment”. In fact, upon information and belief, Tribune does not produce cable television segments at all.

33. Tribune knew or should have known that these statements were false. Indeed, Tribune was in a unique position to know the truth of these statements because they published the newspaper and were aware Kyles and any other REDEYE reporters appeared on television only to promote the REDEYE newspaper.

34. Indeed, the degree of Tribune’s knowledge is underscored by the fact that shortly after commencing the District Court Action, only about one month after swearing to the Application, and before filing the Response, Hirt testified that the use of REDEYE on CLTV “just extends our brand to more viewers, which would presumably hopefully get them to pick up the paper.”

35. Tribune’s use of REDEYE on CLTV is merely normal and ancillary to the promotion of the REDEYE newspaper. The use of REDEYE on television is not a separate good or service rendered by Tribune, but, rather, is merely an ancillary or promotional use to the newspaper.

36. Tribune’s knowing and material misrepresentations in the Application and Response conferred a substantial benefit on Tribune because, as discussed below, the filing of the Application provides Tribune with priority of registration such that the Application bars FNC from obtaining registrations for RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design).

37. For this reason, as discussed more fully below, Tribune’s knowing and material misrepresentations in the Application and Response have damaged FNC. Tribune should not be

permitted to obtain a trademark registration in REDEYE in connection with “production of cable television segments” because it does not and has not used its mark in commerce for that purpose. Its contrary representations to the PTO were knowingly false and were designed to induce the PTO to give Tribune a registration to which it is not entitled.

C. Tribune Made Knowing False Statements In The Application And Response About Its Use Of The Subject Mark On The Internet

38. In addition, Tribune made material misrepresentations about the use of REDEYE on the Internet. Specifically, contrary to the statements contained in the Application and the Response, Tribune did not use REDEYE in commerce on the Internet “as least as early as October 30, 2002”. Instead, Tribune only minimally used REDEYE on the Internet until July 2006, and any use was solely to promote the REDEYE newspaper.

39. As Brad Moore, the General Manager of REDEYE testified, although Tribune launched the website www.redyechicago.com at the same time as the newspaper in October 2002, “the primary purpose of the website at that time was an informational site for the newspaper.”

40. According to Moore’s further testimony, the website remained unchanged until July 2006.

41. Indeed, Hirt echoed this sentiment, testifying under oath that between October 2002 and July 2006, “it was kind of a business-to-business site that just had information on how to advertise and just a little bit of editorial, and in ’06, summer of ’06 we redesigned it to add a lot more editorial things for people to read and click on.”

42. Accordingly, despite the sworn statements in the Application, Tribune did not use the Subject Mark in commerce on the Internet within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. §§ 1051 and 1127 “at least as early as October 2002”. Instead, it

merely used the website to promote the REDEYE newspaper. The use of REDEYE on the website was not a separate good or service provided by Tribune, but is rather merely an ancillary use.

43. Accordingly, Tribune's sworn statement that used REDEYE in commerce on the Internet "at least as early as October 2002" is a material misrepresentation. The statement was designed to give Tribune an advantage in its litigation with FNC, as well as priority of registration to bar FNC from obtaining registrations for RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design).

44. Tribune knew or should have known that this statement was false. Indeed, Tribune was in a unique position to know that truth of this statement because they published the newspaper and were aware that REDEYE was only used on the Internet to promote the REDEYE newspaper.

45. Indeed, the degree of Tribune's knowledge is underscored by the fact that shortly after commencing the District Court Action, only about one month after swearing to the Application, and *before* filing the Response, Moore and Hirt testified that the use of REDEYE on the Internet was designed to promote the REDEYE newspaper and sell advertising therein.

46. Tribune's use of REDEYE on the Internet was merely normal and ancillary to the promotion of the REDEYE newspaper. The use of REDEYE on Internet was not a separate good or service rendered by Tribune, but is rather merely an ancillary use solely to promote the newspaper.

47. Tribune's knowing and material misrepresentations in the Application and Response conferred a substantial benefit on Tribune because, as discussed below, the filing of the Application provides Tribune with priority of registration such that the Application bars FNC

from obtaining registrations for RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design).

48. For this reason, as discussed more fully below, Tribune's knowing and material misrepresentations in the Application and Response have damaged FNC.

D. FNC Has Been Harmed By Tribune's Fraud

49. On June 7, 2007, FNC filed applications with the PTO to register its marks, RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design) ("FNC's Applications"), in connection with "entertainment services in the nature of an on-going television news program". The PTO assigned FNC's Applications Serial Nos. 77/200,629 and 77/200,700, respectively.

50. In response to FNC's Applications, the PTO issued an Office Action for each on September 14, 2007, citing an initial refusal to register based on a likelihood of confusion with Tribune's Registrations for REDEYE and REDEYE I (& Design) for newspapers. The PTO also cited the Application, as well as to Tribune's other co-pending application for REDEYE, as potentially conflicting prior applications.

51. On March 4, 2008, FNC filed its Responses to Office Action for FNC's Applications for RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design).

52. On April 8, 2008, the PTO issued Notices of Suspension with respect to FNC's Applications. In addition to refusing to register FNC's marks based on a perceived likelihood of confusion with Tribune's Registrations for the marks REDEYE and REDEYE I (& Design) in connection with newspapers, the PTO stated, "Action on this application is suspended pending the disposition of: Application Serial No(s). 77101529 and 77101706." Thus, FNC's

application has been suspended pending disposition of Tribune's Applications.

53. FNC's television program remains on the air to this day.

54. FNC actually uses its mark in connection with cable television services and should not be prevented from registering its mark based on Tribune's fraudulent Application.

55. FNC cannot obtain registrations for its own lawful use of its mark while Tribune's Application is pending. On information and belief, if the registration for Tribune's fraudulent Application issues, FNC's mark will be denied registration by the PTO.

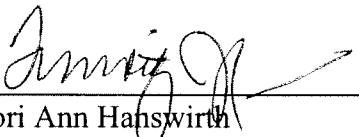
WHEREFORE, Opposer FNC prays that this opposition be sustained and that no registration be issued on Application Serial Number 77,101,706 to Applicant Tribune.

Respectfully submitted,

HOGAN & HARTSON L.L.P.

Date: September 23, 2008

By:


Dori Ann Hanswirth
Timothy J. Lyden
Attorneys for Opposer,
Fox News Network, LLC

Please direct correspondence to:

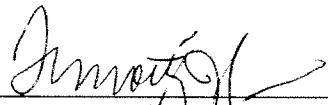
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**CERTIFICATE OF SERVICE
IN ACCORDANCE WITH 37 CFR § 1.8 and 2.119**

I HEREBY CERTIFY that on this 23rd day of September, 2008, a true and complete copy of the foregoing Amended Notice of Opposition was served by first-class mail, postage prepaid, addressed to the following:

Salvador K. Karottki, Esq.
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Counsel to Applicant

By: 
Timothy J. Lyden